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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,356	08/10/2001	Thomas D. Gordon	00537-188002	7156
37903	7590	03/26/2004	EXAMINER	
DAWN JANELLE AT BIOMEASURE INC. 27 MAPLE STREET MILFORD, MA 01757			COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/868,356	Applicant(s) GORDON ET AL.	
	Examiner Brenda L. Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-21 is/are pending in the application.  
     4a) Of the above claim(s) 1-4, 6, 8, 11, 15, 16, 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 7, 9, 10, 12-14 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-16 and 19-21 are pending in the application.

This action is in response to applicant's amendment filed January 14, 2004.

Claims 1, 9, 10, 15 and 16 have been amended and claims 20 and 21 are newly added.

### ***Election/Restrictions***

1. Claims 1-4, 6, 8, 11, 15, 16 and newly added claims 20 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention where  $n1 = 0$ , there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

This application contains claims 1-4, 6, 8, 11, 15, 16 and newly added claims 20 and 21 are drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Response to Amendment***

Applicant's amendments and arguments filed January 14, 2004 have been fully considered with the following effect:

2. With regards to the rejection of claims 1, 2, 5, 7 and 14-18 as being drawn to an improper Markush group, the applicants stated that they have amended claim 1 to limit the claimed compound to compounds containing an imidazobenzodiazepine ring, in particular,  $n1 = 0$  has been deleted thus requiring that the central ring be a 7-membered ring. However, this is not so, the applicants have amended claim 1 such that  $n1 = 0$

which is drawn to non-elected invention. The applicants also stated that, it is now a requirement that  $R^{10}$  form a benzene ring with either  $R^7$  or  $R^6$  and that these amendments eliminate the possibility that the central ring is a 6-membered ring or that a benzene group is not fused to the central ring. Applicants submit that the instant application is now directed solely to Group I pursuant to the Restriction required by the Office Action mailed November 13, 2002 (Paper 7). However, Group I in the Restriction required by the Office Action mailed November 13, 2002 is directed to compounds, compositions and method of use of the compounds of formula I where  $n_1 = 1$  and formula I forms an **imidazobenzodiazepine** ring, i.e. requires further fusion. Upon further review claims 5 and 7 are withdrawn from the rejection as being directed solely to compounds of formula I where  $n_1 = 1$  and formula I forms an imidazobenzodiazepine ring and claims 1, 2 and 16 are withdrawn as being directed to a non-elected invention.

Claim 14 is rejected as being drawn to an improper Markush group. The recited compounds, while possessing a common utility, differ widely in structure and are not art-recognized equivalents and are thus, independently distinct for the reasons set forth in the restriction requirement, for reasons of record and stated above.

3. The applicants amendments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection of claims 15, 17 and 18, labeled paragraph 4) in the last office action, which is hereby **withdrawn**. Claim 15 is currently withdrawn and claims 17 and 18 were canceled by amendment.

4. The applicants amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of claims 9, 10, 17 and 18, labeled paragraph 5) in the last office action, which are hereby **withdrawn**.

5. The applicants amendments are sufficient to overcome the obviousness-type double patenting rejection of claims 15-18, labeled paragraph 6) in the last office action, which is hereby **withdrawn**. Claim 15 and 16 are currently withdrawn and claims 17 and 18 were canceled by amendment.

In view of the amendment dated January 14, 2004, the following new grounds of rejection apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 5, 7, 9, 10, 12-14 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 5 recites the limitation "1" in the definition of n1. There is insufficient antecedent basis for this limitation in the claim.
- b) Claim 7 recites the limitation "1" in the definition of n1. There is insufficient antecedent basis for this limitation in the claim.

- c) Claim 9 recites the limitation "imidazo[1,2-c][1,4]benzodiazepine" in the nomenclature of the species. There is insufficient antecedent basis for this limitation in the claim.
- d) Claim 10 recites the limitation "imidazo[1,2-c][1,4]benzodiazepine" in the nomenclature of the species. There is insufficient antecedent basis for this limitation in the claim.
- e) Claim 12 recites the limitation "imidazo[1,2-a][1,4]benzodiazepine" in the nomenclature of the species. There is insufficient antecedent basis for this limitation in the claim.
- f) Claim 13 recites the limitation "imidazo[1,2-a][1,4]benzodiazepine" in the nomenclature of the species. There is insufficient antecedent basis for this limitation in the claim.
- g) Claim 14 recites the limitation "imidazo[1,2-c][1,4]benzodiazepine or imidazo[1,2-a][1,4]benzodiazepine " in the nomenclature of the species. There is insufficient antecedent basis for this limitation in the claim.
- h) Claim 19 recites the limitation "imidazo[1,2-c][1,4]benzodiazepine" in the nomenclature of the species. There is insufficient antecedent basis for this limitation in the claim.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 09/868,356

Page 7

Art Unit: 1624

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Brenda Coleman". The signature is fluid and includes a long horizontal flourish at the end.

Brenda Coleman  
Primary Examiner Art Unit 1624  
March 24, 2004